



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,610	05/30/2001	Nobumasa Hirai	Q64728	5530

7590 04/30/2003
SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER

TRAN LIEN, THUY

ART UNIT	PAPER NUMBER
----------	--------------

1761

DATE MAILED: 04/30/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/866,610

Applicant(s)
Hirai et al

Examiner
Lien Tran

Art Unit
1761



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan. 27, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 11-18 is/are rejected.
- 7) ☒ Claim(s) 9 and 10 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 1761

1. The substitute specification filed Jan. 27, 2003 has not been entered because it does not conform to 37 CFR 1.125(b) because: it is not accompanied by a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

While applicant states in the response that a marked-up copy was filed, there was no marked-up copy found in the response.

2. Claims 11 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 is vague and indefinite. Applicant incorporates the limitation of claim 4 into claim 11 and the limitation is already cited in claim 11. It seems like a typographical error.

Claim 17 is vague and indefinite. It is not see how claim 17 further limits claim 4 when it repeats the limitation of claim 4.

3. The objection to claims 9-10 as being in improper form is maintained because a multiple dependent claim must refer to a preceding claim. Claims 9-10 depend from claims 12,13,14 or 15 which are subsequent claims.

4. The 112 second paragraph rejection of claims 7,12,13 is hereby withdrawn.

5. Claims 1-8, 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jp 2000044878 in view of Nisperos-Carriedo et al and Orthoefer.

Art Unit: 1761

Jp2000044878 discloses a coating agent which comprises a yeast cell wall fraction mainly comprising a microbial cell residue. The coating agent is used as coatings of foodstuff, pharmaceuticals, enzyme, microorganisms, flavoring agent etc... The coating agent has very low oxygen permeability, not stickiness and controls an elution initiation time. Applicant discloses on page 3 of the specification, the patent also teaches to incorporate a plasticizer-in-the-coating material.

The Japanese patent does not disclose one member selected from a group consisting of viscous polysaccharides, oligosaccharide, fats or oil, sugar alcohol or the specific polysaccharide and oligosaccharide as claimed in claims 2-3,6-7.

Orthoefer discloses plasticizers including sugar alcohol, polysaccharide, oligosaccharide such as raffinose, triglycerides such as vegetable oil. (See columns 3-4 which disclose all the materials which can be used as plasticizers)

Nisperos-Carriedo et al disclose plasticizers such as carnauba wax, candellila wax, beeswax, soybean oil and mannitol. (See column 4 lines 17-22)

The Japanese patent teaches to incorporate plasticizer in the coating agent. It would have been obvious to one skilled in the to use any known plasticizer such those disclosed by Orthoefer and Nisperos-Carriedo et al. As to the size, it would have been obvious to make the product in the size that is appropriate to the intended use. For example, if the coated powder is used in a liquid product, it would have been obvious to make the product in small size so that it would dispersed readily in the liquid. However, if the coated powder is used into a solid food product or

Art Unit: 1761

pharmaceuticals, the size can be bigger. One skilled in the art can readily determine the appropriate size through routine experimentation, depending on the intended use. It would also have been obvious to one skilled in the art to determine the coating ratio through routine experimentation to obtain a product which provides the most optimum intended function. For example, if the core agent is coated to enhance shelf stability by providing a barrier layer, it would have been obvious to have a thicker coating versus a core agent which is coated to control release time.

6. Claims 11 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jp2000044878 in view of Nisperos-Carriedo et al and Orthoefer as applied to claims 1-8 and 12-17 above, and further in view of Percel.

The Japanese patent abstract is silent about the process by which the core agent is coated.

Percel et al teach a process to coat core particles. The process comprises the steps of forming a fluid bed of the core particles and spraying into the bed in the form of a fine mist the coating agent. (See columns 3-4)

It would have been obvious to one skilled in the art to use the Percel et al process in order to coat core particles with the coating agent disclosed in the Japanese patent.

7. Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lien Tran whose telephone number is 703-308-1868. The examiner can

Application/Control Number: 09/866610


Page 5

Art Unit: 1761

normally be reached on Wed-Fri. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

April 25, 2003


LIEN TRAN
PRIMARY EXAMINER
Group 1700